



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,599	08/13/2001	Lee Anne Kowalski	SVL920010049US1	7529
22462 7590 09/19/2008 GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045				
EXAMINER				
ORR, HENRY W				
ART UNIT		PAPER NUMBER		
2176				
MAIL DATE		DELIVERY MODE		
09/19/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/928,599

**Applicant(s)**

KOWALSKI, LEE ANNE

**Examiner**

Henry Orr

**Art Unit**

2176

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-23, 26-45 and 48-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-23, 26-45 and 48-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 3/11/2002

**DETAILED ACTION**

1. This action is responsive to applicant's amendment dated 7/15/2008.
2. Claims 1, 4-23, 26-45 and 48-66 are pending in the case.
3. Claims 2, 3, 24, 25, 46 and 47 are cancelled.
4. Claims 1, 23 and 45 are independent claims.

**Applicant's Response**

5. In Applicant's response dated 7/15/2008, applicant has amended the following:
  - a) Claims 1, 23 and 45

Based on Applicant's amendments and remarks, the following objections and rejections previously set forth in Office Action dated 4/15/2008 are withdrawn:

- a) 35 U.S.C. 101 Rejection to claims 23, 26-45, 48-66

***Information Disclosure Statement***

6. The information disclosure statement (IDS) submitted on 3/11/2002 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick et al. (hereinafter "Padwick"), Special Edition Using Microsoft Outlook 2000 (Que Publishing, 12, May, 1999), in view of Chen et al. (hereinafter "Chen"), U.S. Patent No. 6,009,442 of record.**

*Claim 1:*

Padwick discloses *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Chapter 22 – Creating and Using Rules, "Using the Rules Wizard to Manage Incoming Messages" Pages 1-19 of 19 → Padwick discloses this limitation in that Outlook includes an "Rules Wizard" tool that allows the user to search emails for a particular term or phrase), *comprising the steps of:*

- *creating and reading electronic messages in an electronic messaging application performed by a computer* (Padwick discloses this limitation in that Outlook allows the user to create and read emails), *wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network* (Padwick discloses this limitation in that Outlook sends emails created by the user to a recipient via a computer network), *and the electronic messaging application identifies certain words that are contained within the electronic message* (as explained in the immediately following discussion, Padwick discloses this limitation) *by performing the steps of:*

- *comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry* (see Figure 22.15; see Pages 1-15 of 19 → Padwick discloses this limitation in that the "Rules Wizard" tool allows the user to create rules to filter emails based on whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are "stored" by an "online registry."); and
- *identifying the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched significant message terms to a folder* (see Figure 22.15; see Pages 1-15 of 19 → Padwick discloses this limitation in that the "Rules Wizard" tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick "identifies the matched message terms" and "indicates their significance to a reader.").

Padwick fails to expressly disclose:

- *the electronic messaging application **distinguishing** certain words that are contained within the electronic message by performing the step of:*

- ***making alterations*** to the electronic message to identify the matched message terms and to indicate their significance to a reader

**(EXAMINER'S INTERPRETATION** – These two phrases (i.e., “an application that distinguishes certain words” and “making alterations to the electronic message” essentially recite the same subject matter. That is, these limitations recite: an “electronic messaging application” that automatically “distinguishes” certain words in a “message” by “making alterations” to those words for the purpose of indicating the significance of those words to a reader of the “message.”), *wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.*

Chen teaches a computer-implemented method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising:*

- *an electronic messaging application distinguishing certain words that are contained within the electronic message (as explained in the immediately following discussion, Chen teaches this limitation) by performing the step of:*

- *making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient* (see Figure 1B; see Column 3, Line 37 through Column 4, Line 5; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. When a user-specified keyword is detected in an email, the system designates the email for storage in a user-specified folder. In this way, the system “alters the email.” Subsequently, when the email is viewed by the user, the system highlights the user-specified keyword. By highlighting the user-specified keywords, Chen “*identifies matched message terms*” and “*indicates their significance to a reader.*” Additionally, the system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*altering the electronic message when authored by its originator or received by its recipient.*”),

for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *an electronic messaging application distinguishing certain words that are contained within the electronic message by performing the step of:*
  - *making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient,*

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 4:*

Padwick discloses *significant terms that are determined based upon a reader profile* (see Chapter 22 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” → Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “*reader*”; these rules comprise the “*reader profile*” that determines the “*significant terms*”).



Padwick fails to expressly disclose *an electronic message that is altered when received*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*altering the electronic message when received*.”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include

the step of *altering the electronic message when received*, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 5:*

Padwick discloses *significant terms that are determined based upon a author profile* (Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create rules for processing outgoing emails for the "author"; these rules comprise the "*author profile*" that determines the "*significant terms*").

Padwick fails to expressly disclose *an electronic message that is altered when authored*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen

teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches *"altering the electronic message when authored."*); for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of *altering the electronic message when authored*, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 6:*

Padwick fails to expressly disclose:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received.*

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the

document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*matched message terms that are identified based upon a reader profile*” and “*altering the electronic message when received.*”),

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received,*

for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

*Claim 7:*

Padwick fails to expressly disclose/teach:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored.*

Chen teaches a method for identifying and distinguishing words contained within an electronic message (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches

*"matched message terms that are identified based upon an author profile" and*  
*"altering the electronic message when authored.");*  
for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick to include the step of:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored,*

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

*Claim 8:*

Padwick discloses *the step of collecting and storing significant terms in the online registry* (see Chapter 22 – Creating and Using Rules; *"Using the Rules Wizard to Create Rules that Manage Incoming Messages"* Pages 1-19 of 19 and *"Creating Rules for Outgoing Messages"* Pages 1-2 of 2 → Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create and save rules for searching incoming or outgoing emails for particular terms. Thus, the rules constitute an *"online registry" of "significant terms."*

*Claim 9:*

Padwick discloses a *step of collecting and storing [that] comprises a user selecting significant terms* (Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user "*selects significant terms*").

*Claim 10:*

Padwick discloses a *step of collecting and storing comprises importing significant terms* (see Chapter 22 – Creating and Using Rule; "*Managing Rules*" → Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

*Claim 11:*

Padwick discloses *significant terms are imported from an address book* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a "file" includes an address book).

*Claim 12:*

Padwick discloses *significant terms are imported from a database* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a "file" includes a database).

*Claim 13:*

Padwick discloses *significant terms comprise names of people, product terms or key words in a user's field* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include "names of people"; for example, see Figure 28.4).

*Claims 14-16:*

Padwick, in view of Chen, fails to expressly disclose:

- *making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.*

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well known by one of ordinary skill in the art at the time the invention was made. Chen expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user. Changing the font effect, font type, and/or color of text in an electronic document



was well known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art (e.g., computer programmers) would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of facilitating aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type, for the purposes of aesthetics and distinguishing the different search requests within each email.

*Claim 19:*

Padwick discloses *identifying where the alterations to the matched message terms*, taught by Chen, *[is to be] performed according to a user setting* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search

terms; thus, making the search term "distinct" is performed "according to a user setting").

*Claim 20:*

Padwick discloses *significant terms [that] are categorized and the user setting is based upon a category of the significant term* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way. For example, Outlook can search for all emails that include the term "deadline" and send those emails to a certain folder, or Outlook can search for all emails that include the term "office party" and delete those emails. Thus, the significant terms are "categorized" and the user setting processes emails having the significant terms "*based on a category of the significant term.*").

*Claim 21:*

Padwick fails to expressly disclose *displaying the electronic message if the end of the electronic messages as been reached.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the

system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *displaying the electronic message if the end of the electronic messages as been reached* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows the user to click on any document in a list of documents meeting the user-specified criteria and, upon selection of one of the listed documents by the user, displays the document with the highlighted search term, Thus, the system has scanned the document for the significant term and displays the document “*if the end of the electronic messages as been reached.*”),

for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of displaying the electronic message if the end of the electronic messages as been reached* for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

*Claim 22:*

Padwick fails to expressly disclose *querying a user before making alterations to the electronic message*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *querying a user before making alterations to the electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows the user to search documents for particular terms and distinctly displays those terms when one of the documents meeting the user-specified criteria is displayed.

Thus, the system “*queries the user before making alterations to the electronic message.*”),

for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include

the *step of querying a user before making alterations to the electronic message*, for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

*Claims 23, 26-38 and 41-44:*

These claims merely recite an apparatus for performing the method of Claims 1, 4-16 and 19-22. Padwick discloses and Chen teaches computer systems.

Thus, Claims 23, 26-38 and 41-44 remain rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

*Claims 45, 48-60 and 63-66:*

These claims merely recite computer software for performing the method of Claims 1, 4-16 and 19-22. Both Padwick and Chen operate via computer software.

Thus, Claims 45, 48-60 and 63-66 remain rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

**8. Claims 17, 18, 39, 40, 61 and 62 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Chen, and further in view of Larson et al., U.S. Patent No. 5,825,854.**

*Claim 17:*

As indicated in the above discussion, Padwick, in view of Chen, discloses/teaches every limitation of Claim 1.

Padwick, in view of Chen, fails to expressly disclose:

- *inserting an object into the electronic message near the matched message term.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *inserting an object into the electronic message near the highlighted message term* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 →

Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message), for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *inserting an object into the electronic message near the matched*

*message term*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

*Claim 18:*

Padwick, in view of Chen, fails to expressly disclose:

- *an object that comprises an image, a sound file, an icon, a link or a video.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *selecting an object that comprises an image, a sound file, an icon, a link or a video* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *selecting an object from the group consisting of an image, a sound file, an icon, a link and a video*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

*Claims 39 and 40:*

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses and both Chen and Larson teach computer systems.

Thus, Claims 39 and 40 remain rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

*Claims 61 and 62:*

These claims merely recite computer software for performing the method of Claims 17 and 18. Padwick, Chen and Larson operate via computer software.

Thus, Claims 61 and 62 remain rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.



***Response to Arguments***

9. Applicant's arguments filed 7/15/2008 have been fully considered but they are not persuasive.

**Prior Art Rejections**

Applicant alleges that the rejections based on Padwick-Outlook 2000 and Chen were last presented in the Office Action dated November 29, 2005, were previously overcome in the response filed by Applicants' attorney dated February 27, 2006, as acknowledged by the rejections' absence in the Office Action dated April 25, 2006 (see Response; p. 10).

Examiner respectfully disagrees.

Examiner notes that the rejections based on Padwick-Outlook 2000 and Chen are not absent in the Office Action dated April 25, 2006 (see p. 29 of Action dated 4/25/2006). Furthermore, the rejections based on Padwick-Outlook 2000 and Chen are not absent on the subsequent actions of November 29, 2005. Therefore, Examiner has never explicitly or implicitly acknowledged that Applicant has sufficiently overcome the applied rejections based on Padwick-Outlook 2000 and Chen.

Applicant argues that Chen fails to teach or suggest making alterations to the electronic message to identify the matched message terms and to indicate their significance, wherein the alterations were made by an electronic messaging application, because Chen is not an "electronic messaging application" since emails must be imported into its document management system. (see Response; p. 11).

Examiner respectfully disagrees.

Chen teaches a document management system that, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. When a user-specified keyword is detected in an email, the system designates the email for storage in a user-specified folder. Subsequently, when the email is viewed by the user, the system highlights the user-specified keyword. In Chen, the email application and the "highlighting keywords" application are components of the larger "document management system." Thus, Chen teaches an "electronic messaging application" that makes alterations to an electronic message.

Essentially, Applicant is arguing that the "highlighting keywords" application in Chen is part of a larger "document management system" and is not limited solely to an email application. In the world of computers and software, reciting in a claim that a software function is performed by an "application" rather than a "system" will not make

the claim patentable when the prior art discloses software that performs the software function.

Lastly, Examiner notes that the subject matter previously relied upon in Padwick, Outlook 2002 in Action dated 11/13/2007 before being eliminated by Applicant's submission of Declarations under 37 C.F.R. 1.131 is substantially the same subject matter relied upon in Padwick, Outlook 2000. Therefore, Examiner merely replaces Padwick, Outlook 2002 reference with the already of record Padwick, Outlook 2000 reference to teach the same recited claim limitations.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry Orr whose telephone number is (571) 270 1308. The examiner can normally be reached on Monday thru Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/16/2008  
HO

/Rachna S Desai/  
Primary Examiner, Art Unit 2176